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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,195	03/30/2004	Bernd Luhmann	tcsa 1634-WCG	5145
27386	7590	02/22/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,195

Applicant(s)

LUHMANN ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/30/04, 5/16/04, 8/16/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-13 and 15-17) in the reply filed on February 3, 2006 is acknowledged. The traversal is on the ground(s) that any search of the elastic adhesive is certain to include the search of the process of producing it and accordingly, no additional burden would be placed on the Patent Office in searching both groups together. This is not found persuasive because the search for group I invention is different from that of Group II as shown in the last Office Action of December 1, 2006, and hence, a search of the two invention group areas would be of burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 and 15-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 and 10-19 of U.S. Patent No. 10/815894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the application'894 are directed to an adhesive tape comprising one layer of pressure sensitive adhesive based on chemically crosslinked polyurethane, wherein the starting material includes isocyanate reactive substance having functionality of more than 2.0, the ratio of the hydroxyl group in the diol to that in the triol is less than 10, the ratio of the isocyanate groups to that of the hydroxyl groups is between 0.8 and 1.15, the molecular weight of the diols is 1000 or greater and that of the triols is less than 1000. However, the application'894 fails to teach that the amount of isocyanate is at least 5% by weight of the polyurethane composition, that the adhesive sheet has a stretchability of more than 200%, that the tensile stress at elongation of 200% is not more than 2.0 N/sqmm, and that the ratio of tensile stress to stripping stress being more than 1.2. It would have been obvious to one having ordinary skill in the art for the claimed adhesive tape of application'894 to exhibit the characteristic of elongation, stress ratio, tensile stress and amount of isocyanate in the polyurethane composition, based on optimization through routine experimentation, since all the components of the adhesive are the same as being claimed in the instant application.

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4. Claims 1-13 and 15-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 10/826965. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the application'965 are directed to an adhesive tape comprising one layer of pressure sensitive adhesive based on chemically crosslinked polyurethane, wherein the starting material includes isocyanate reactive substance having functionality of more than 2.0, the ratio of the hydroxyl group in the diol to that in the triol is less than 10, the ratio of the isocyanate groups to that of the hydroxyl groups is between 0.8 and 1.15, the molecular weight of the diols is 1000 or greater and that of the triols is less than 1000. However, the application'965 fails to teach that the amount of isocyanate is at least 5% by weight of the polyurethane composition, that the adhesive sheet has a stretchability of more than 200%, that the tensile stress at elongation of 200% is not more than 2.0 N/sqmm, and that the ratio of tensile stress to stripping stress being more than 1.2. It would have been obvious to one having ordinary skill in the art for the claimed adhesive tape of application'965 to exhibit the characteristic of elongation, stress ratio, tensile stress and amount of isocyanate in the polyurethane composition, based on optimization through routine experimentation, since all the components of the adhesive are the same as being claimed in the instant application.

5. Claims 1-13 and 15-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-11 of U.S. Patent

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No. 10/816277. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the application'277 are directed to an adhesive tape comprising one layer of pressure sensitive adhesive based on chemically crosslinked polyurethane, wherein the starting material includes isocyanate reactive substance having functionality of more than 2.0, the ratio of the hydroxyl group in the diol to that in the triol is less than 10, the ratio of the isocyanate groups to that of the hydroxyl groups is between 0.8 and 1.15, the molecular weight of the diols is 1000 or greater and that of the triols is less than 1000. However, the application'277 fails to teach that the amount of isocyanate is at least 5% by weight of the polyurethane composition, that the adhesive sheet has a stretchability of more than 200%, that the tensile stress at elongation of 200% is not more than 2.0 N/sqmm, and that the ratio of tensile stress to stripping stress being more than 1.2. It would have been obvious to one having ordinary skill in the art for the claimed adhesive tape of application'277 to exhibit the characteristic of elongation, stress ratio, tensile stress and amount of isocyanate in the polyurethane composition, based on optimization through routine experimentation, since all the components of the adhesive are the same as being claimed in the instant application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being obvious over Schumann (2004/0038040).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

8. Schumann relates to a pressure sensitive adhesive (PSA) sheet wherein the PSA is based on a chemically crosslinked polyurethane (abstract). However, Schumann fails to teach that the sheet has a maximum stretchability of more than 200%, that the ratio of tensile stress to stripping stress being more than 1.2, that the tensile stress is

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not more than 2.0 N/sqmm at 200% elongation. It would have been obvious to one having ordinary skill in the art for the adhesive of Schumann to exhibit the characteristic of elongation, stress ratio and tensile stress, etc., based on optimization through routine experimentation, since all the components of the adhesive are the same as being claimed in the instant application.

Further, the claimed starting materials components (claims 1-6 and 16-17) have not been given any patentable weight because the claim is directed to an adhesive sheet, which is understood by the examiner to have no starting material present therein.

Regarding claims 7 and 8, Schumann teaches the presence of a backing on one side of the adhesive and the adhesive sheet being a multi-ply laminate (abstract).

The presence of the protective film on the sheet would provide for the non-tacky surface. The adhesive sheet includes additives as recited in claim 10 (paragraph-[0044]). A method of fastening materials such as paint to a surface is also taught paragraph-[0066].


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 2/19/06
Primary Examiner
Art Unit 1772

N. Ahmad.
February 19, 2006.